

REMARKS

Applicant appreciates the Examiner's thorough examination of the subject application and requests reconsideration of the subject application based on the foregoing amendments and the following remarks.

Claims 1-23 are pending in the subject application.

Claims 1-4 and 11-16 are acknowledged as being allowable by the Examiner.

Claims 5-10, 17, 18, 20 and 22 stand rejected under 35 U.S.C. §103. Claims 19 and 23 were objected to as depending from a rejected base claim; however, the Examiner indicated that the claims would be allowable if appropriately re-written in independent form. Claim 21 was objected to because of identified informalities. As to claim 21, however, this claim also was indicated on the Office Action Summary page as being rejected although not specifically discussed in the grounds for rejection in the Office Action. Applicant understands that claim 21 would be allowable if amended so as to depend from claim 13 as suggested by the Examiner.

Claim 19 was canceled in the instant amendment and the limitations added to claim 5.

Claim 23 was written in independent form as suggested by the Examiner.

Claims 13, 14, 16 and 20 were amended for clarity. It seemed from the Examiner's rejection of claim 20, that a prior user of a camera was not "one other than the user" as that term is used in the claims and the subject application. Thus, and for purposes of clarity, each of claims 13, 14, 16 and 20 were amended to change "one other than the user" to --an authorized one--. As described in the subject application, the camera is not recycled for further use by any

user but rather only by persons, companies and the like who the camera is returned to for such recycling, in other words someone authorized to recycle the camera.

Claim 18 was also amended for clarity so as to clarify that such stoppage of the current is for any user.

Claim 21 was amended as suggested by the Examiner so it now depends from claim 13.

The amendments to the claims are supported by the originally filed disclosure. It also is respectfully submitted that the amendment(s) to the claims does/ do not require further search and consideration and thus, entry of these amendments into the subject application is respectfully requested.

35 U.S.C. §103 REJECTIONS

Claims 5-10, 17, 18, 20 and 22 stand rejected under 35 U.S.C. §103 as being unpatentable over Ushiro [USP 4,511,932] in view of Murata et al. [USP 5,627,587; "Murata"] for the reasons provided on pages 2-6 of the above-referenced Office Action. Applicant respectfully traverses as discussed below. Because claims were amended in the instant amendment, the following discussion refers to the language of the amended claims. However, only those amended features specifically relied upon to distinguish the claimed invention from the cited prior art shall be considered as being made to overcome the cited reference.

As indicated herein claim 5 was amended so as to include the limitations of claim 19. In the above-referenced Office Action at page 6 thereof, it was indicated that claim 19 was

allowable because the art did not teach nor fairly suggest the use of a video camera having a current stop portion as recited in claim 19. As such, Applicant believes that the addition of the limitations of claim 19 to claim 5, distinguishes the as-amended claim 5 from the cited art.

As to claims 6-10, 17, 18, 20 and 22, each of these claims depends directly or ultimately from claim 5. Applicant respectfully submits that at least for this reason each of these claims are distinguishable from the cited art. This shall not be construed, however, as admission that there are not other reasons on which any one or more of claims 6-10, 17, 18, 20 and 22 are distinguishable from the cited combination of references.

Applicant would further note that claim 20 is also distinguishable from the cited art, as the grounds for rejection of this claim amounts to a suggestion that a subsequent user is not a user as that term is used in the claim. For example, it was asserted in the office action that as to claim 20 a new user supplying the camera with a new video cassette is considered to be the reconditioning. Claim 20 was amended to clarify to use the term "authorized one" instead of "one other than the user" as who is doing the reconditioning, etc., actions associated with the recycling of the camera for further uses as described in the subject application. As indicated in the subject application, recycling of the camera is not being carried out by one who is just a user of the camera but rather by one to whom the camera has been returned to for such reconditioning (e.g., recycling). It is respectfully submitted that this is not disclosed or taught in Murata.

As to claim 18, the Office Action referred to teachings in Murata that were asserted to as corresponding to the current stop function operation when the cartridge was removed; however,

the following remarks in Murata concerning continuing operation of the camera following insertion of a new cartridge (see col. 4 thereof) were not also considered in connection with the assertion against the claimed current stop function of claim 18. The teachings in Murata provide that if a cartridge is inserted and thus the opening is necessarily closed, then operation of the camera is continued. Whereas in the present invention; when an opening is detected the current stop portion operates to stop the current supply to one of the mechanical portion, the controlling portion or the optical system thereby making the camera unusable for any further or subsequent use by any user. Thus and for clarity, Applicant amended claim 18 to clarify that for any user, not just the user who was, is presently or will be using the camera, the current stop function is being maintained for any subsequent or further use of the camera. It is respectfully submitted that neither of the above is disclosed or taught in Murata.

As provided in MPEP 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F. 2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F. 2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). As provided above, the references cited, alone or in combination, include no such teaching, suggestion or motivation.

Furthermore, and as provided in MPEP 2143.02, a prior art reference can be combined or modified to reject claims as obvious as long as there is a reasonable expectation of success. *In re*

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Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Additionally, it also has been held that if the proposed modification or combination would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. Further, and as provided in MPEP-2143, the teaching or suggestion to make the claimed combination and the reasonable suggestion of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). As can be seen from the forgoing discussion regarding the disclosures of the cited reference(s), there is no reasonable expectation of success provided. As the Federal circuit has stated, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor. *Para-Ordance Mfg. v. SGS Importers Int'l, Inc.*, 73 F.2d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995).

It is respectfully submitted that for the foregoing reasons, claims 5-10, 17, 18, 20 and 22 are patentable over the cited reference(s) and thus, satisfy the requirements of 35 U.S.C. §103. As such, these claims, including the claims dependent therefrom are allowable.

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CLAIMS 19 & 23

In the above-referenced Office Action, claims 19 and 23 were objected to as being dependent upon a rejected base claim. It also was provided in the above-referenced Office Action, however, that these claims would be allowable if rewritten in independent form to include all the limitations of the base claim and any intervening claim(s).

Claim 23 was re-written in the foregoing amendment so as to be in independent form and to include all the limitations of the base claim there being no intervening claim(s). Accordingly, claim 23 is considered to be in allowable form.

Claim 19 was not expressly re-written in independent form as suggested by the Examiner; rather claim 19 was canceled and the limitations thereof were added to the related base claim, claim 5. Accordingly, claim 5 is considered to be in allowable form.

OTHER MATTERS

Applicant has reviewed their records and an initialed PTO-1449 has not been received back from the USPTO for the Information Disclosure Statement dated April 14, 2001, which had been filed with the originally filed application. Accordingly, Applicant respectfully requests that the Examiner reflect their consideration of this IDS in the next official communication from the USPTO. Also and out of an abundance of caution, Applicant is enclosing herewith a copy of the IDS, the PTO-1440 included therewith and a copy of the Japanese patent reference and English Abstract that had been filed therewith for the Examiner's use in case the previously submitted

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IDS is not in the USPTO file for the subject application. Applicant also respectfully requests the Examiner to call the undersigned at below number in the event the Examiner has any other questions or requires any further information as to this IDS and its attachments.

It is respectfully submitted that the subject application is in a condition for allowance.
Early and favorable action is requested.

Applicant believes that additional fees are not required for consideration of the within Response. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, the Commissioner is hereby authorized and requested to charge Deposit Account No. **04-1105**.

Respectfully submitted,
Edwards & Angell, LLP

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By: 
William J. Daley, Jr.
(Reg. No. 35,487)
P.O. Box 55874
Boston, MA 02205
(617) 439- 4444

Customer No. 21,874

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